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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,428	10/28/2003	Guenther Schmidt	34874-360/2003P00634US	4467
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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY & POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111				
EXAMINER				
ARAQUE JR, GERARDO				
ART UNIT		PAPER NUMBER		
3689				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/695,428

**Applicant(s)**

SCHMIDT ET AL.

**Examiner**

Gerardo Araque Jr.

**Art Unit**

3689

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-11, 13-16, 20-26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 13-16, 20-26 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on **3/5/2009** has been entered.

### ***Specification***

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

2. **Claim 14** is objected to because of the following informalities: **in line 17 of claim 14 the Examiner asserts that the terms "graphical user" should be read as "graphical user interface"**. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112, first paragraph***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1, 3 – 11 and 13** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant discloses two interfaces for performing two different functions by the same user, i.e. buyer. However, the Examiner asserts that there is only support for having one interface for providing bid invitations, displaying scores, and receiving user-generated input.

***Claim Rejections - 35 USC § 112, second paragraph***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 11, 14 – 16, 21 – 26, and 28** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. In regards to **claim 11**, it is uncertain as to which interface the applicant is referring to. Is it the first or second?
8. **Claim 14** recites the limitation "**bid aggregator**" in **line 14 of claim 14**. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1, 3 – 5, 7 – 11, 13 – 16, 20, 22 – 26, and 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Buxton et al. (US PGPub 2002/0111889 A1)** in view of **Dan et al. (US PGPub 2002/0178103 A1)**.

11. In regards to **claims 1 and 14**, **Buxton** discloses an article for generating contract documents in a recurring contracting environment, the article comprising a tangible machine-readable storage medium embodying instructions that when performed by one or more processors result in operations, the instructions defining software modules comprising:

a bid invitation generator associated with a buyer and to provide supplemental bid invitation information in the form of a bid invitation, the supplemental bid information including evaluation rules for scoring each bid (**see at least Page 2, 3 ¶ 14 – 15, 26 wherein a method and system is provided which enables a buyer to send out a bid invitation to various vendors as well as providing the necessary parameters in order to score a vendors bid**);

an interface that provides the bid invitation to one or more designated bidders at a plurality of remote computer systems and receives responsive bids from one or more of the remote computer systems from the designated bidders (**Page 2, 3 ¶ 14, 16, 26 wherein an interface is provided to allow a buyer to create and send out bid invitations and receives bids from the vendors**);

a bid aggregator configured to automatically score the bids according to a predetermined scoring standard based on the evaluation rules, the predetermined scoring standard assigning a relative importance to a plurality of terms within the bids

**(Page 2, 6 ¶ 14, 15, 51 wherein the received bids are scored based on the predetermined parameters entered before sending out the bids);**

a second interface that provides a graphical user interface for displaying at least a portion of the scores for the bids and receives user-generated input selecting one of the bids based on its score **(Page 7 ¶ 58 wherein the bids are received, scored, and the buyer selects the bid that matches their parameters);** and

a contract generator configured to form a new contract based on the bid selected via the graphical user interface one of the responsive bids **(Page 7 ¶ 58 wherein a contract is created based on the buyer selection).**

**Buxton** discloses a method and system that allows a buyer to distribute bid invitations to vendors and scores the received bids. **Buxton** further discloses using customer history information, which is stored in a centralized database as well as establishing renewal periods for a contract, wherein one of ordinary skill in the art would have recognized that at the end of the renewal period a notification of some sort would be created **(see at least Page 4 ¶ 35; see also Page 1 ¶ 7 wherein the invite can contain information regarding a contract duration and renewal periods).**

However, **Buxton** fails to explicitly disclose:

a bid invitation generator associated with a buyer adapted to convert the information relating to a previous contract obtained from a contract data store into basic bid invitation information; and

a contract generator configured to form a new contract based on the information relating to a previous contract.

In other words, **Buxton** fails to explicitly disclose:

generating a contract by incorporating information from a previous contract, i.e. renewal contract.

**Dan**, however, discloses that it is old and well known for contracts to be formed from information provided by one or more parties in one or more electronic documents prior to the negotiation. Specifically, **Dan** teaches that a starting state of a contract can be formed from a previous contract (**see Page 1 ¶ 8; Page 2 ¶ 10; Claim 8**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **Buxton** in view of **Dan** to create contracts that can be based on prior contracts, since **Buxton and Dan** teach the concept of using previously stored information as a basis for creating new contracts.

12. In regards to **claim 3, the combination of Buxton and Dan** discloses wherein the contract generator selects the one of the responsive bids from which the new contract is formed (**Buxton Page 7 ¶ 58 wherein a contract is generated based on at least the received bids**).

13. In regards to **claim 4, the combination of Buxton and Dan** discloses wherein a highest scoring bidder according to the predetermined scoring standard is selected for the new contract (**Buxton Page 2, 3, 6 ¶ 14, 17, 50, 51 wherein the bids are received to be weighed and ranked and wherein one of ordinary skill in the art would have found it obvious that the selected bidder would be based on the vendor that closely matched the predetermined parameters, such as highest ranked/scoring bidder**).

14. In regards to **claim 5, the combination of Buxton and Dan** discloses wherein a bid trigger causes the bid invitation generator to generate a bid invitation upon the occurrence of the pending expiration of a prior contract (**see at least Buxton Page 1 ¶ 7 wherein it is disclosed that a renewal period can be established for a contract and one of ordinary skill in the art would have recognized that it is common knowledge that when the contract period is coming to a close a renewal notice of some sort would be created**).

15. In regards to **claims 7 and 22, the combination of Buxton and Dan** discloses wherein the contract generator forms a portion of the new contract based on previously agreed upon terms between the buyer and a selected bidder (**as discussed above, it is old and well known to create contracts on prior contracts, which would include terms that have been previously agreed upon**).

16. In regards to **claims 8 and 23, the combination of Buxton and Dan** discloses wherein the contract generator forms a portion of the new contract based on provisions selected by the buyer during performance of a prior contract (**as discussed above, it is old and well known to create contracts on prior contracts, which would include terms that have been previously agreed upon. Moreover, the it is also obvious to one having ordinary skill in the art that when renewing a contract the new contract would obviously include provisions that are equal to or similar to the provisions of the prior contract, such as the type of product**).

17. In regards to **claims 9 and 24, the combination of Buxton and Dan** discloses wherein the bid invitation offers a plurality of selectable provisions associated with a



contract clause (**Buxton see at least Page 2 ¶ wherein the buyer can establish predefined questions with assigned weight factors in order to allow a vendor to determine whether they are interested in the contract as well as allowing the buyer to determine whether the provided answers to the questions satisfy the buyers parameters**).

18. In regards to **claims 10 and 25**, the combination of **Buxton and Dan** discloses wherein the bid aggregator generates a summary of terms from two or more of the responsive bids (**see at least Page 3 ¶ 16 – 17 wherein the system receives the bids, scores, and ranks the bids**).

19. In regards to **claims 11 and 26**, the combination of **Buxton and Dan** discloses wherein the interface supervises contracting workflow to allow for approval of the new contract (**see at least Page 7 ¶ 58 wherein the system allows the buyer to review the selected bidder and negotiate and finalize the contract**).

20. In regards to **claims 13 and 28**, the combination of **Buxton and Dan** discloses wherein the bid invitation is provided in the form of a term sheet (**see at least Page 14 – 15 wherein although Buxton does not explicitly disclose that the invitation is in the form of a term sheet one of ordinary skill in the art would have recognized that the format is considered to be non-functional descriptive subject matter. In other words, the format in which the invitation is provided does not affect how the method is carried out. One of ordinary skill in the art would have recognized that the method of generating invites, distributing invites, receiving bids, processing bids, selecting bids, and creating a contract is not affected by the**

**format in which the invite is sent in. One of ordinary skill in the art would have recognized that Buxton provides a method and system that allows a buyer to distribute bid invites containing the necessary information to select, review, and create a contract based on, at least, the received bids.).**

21. In regards to **claim 15, the combination of Buxton and Dan** discloses wherein the contract renewal indication is associated with the expiration of a prior contract **(obviously included in that a renewal indication is a notification indicating the expiration of the prior contract).**

22. In regards to **claim 16, the combination of Buxton and Dan** discloses wherein the contract renewal indication comprises instructions from a user to initiate a new contract **(obviously included in that an indication contains a notification informing the user that the prior contract is expiring and because it is a renewal indication the notification information must include information on initiating a new contract).**

23. In regards to **claim 20, the combination of Buxton and Dan** discloses further comprising triggering the generation of a bid invitation upon the occurrence of the pending expiration of a prior contract **(see at least Page 1 ¶ 7 wherein, as discussed above, the RFP allows the buyer to indicate a renewal period or contract duration. Consequently, since the RFP states a renewal period one of ordinary skill in the art would have recognized that at the end of the contract duration a notification indicating a request to renew a contract would also be included).**

24. **Claims 6 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Buxton et al. (US PGPub 2002/0111889 A1)** in view of **Dan et al. (US PGPub 2002/0178103 A1)** in view of **Official Notice**.

25. In regards to **claims 6 and 21, the combination of Buxton and Dan** fails to explicitly disclose wherein a bid trigger causes the bid invitation generator to generate a bid invitation upon the meeting of a target quantity on a prior contract.

However, the Examiner takes **Official Notice** that there are various methods/triggers for a renewal contract to go into effect. For example, one of ordinary skill in the art would have recognized that it is common business practice for participating entities to negotiate on various terms before signing a contract. In situations regarding renewal contracts it is old and well known for the renewal contract to trigger a notification to renew the contract based on, at least, warranties (warranty expiration), duration/expiration of the prior contract, quantity, and etc.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **the combination of Buxton and Dan** to trigger the renewal of a contract based on at least reaching a target quantity since it is common knowledge that there are various conditions that can be incorporated into a contract to trigger a renewal of the contract.

#### ***Response to Arguments***

26. Applicant's arguments with respect to **claims 1, 3 – 11, 13 – 16, 20 – 26, and 28** have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure can be found in the PTO-892 Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. A./  
Examiner, Art Unit 3689  
3/17/09

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
3/23/09